

Serial No. 10/712,494  
Filed: November 13, 2003

The June 22, 2006, Office Action required an election under 35 U.S.C. § 121 from two Groups. In response, Applicants provisionally elect the invention of Group I, claims 1-6 and 11-13, and the species of claim 2 for further prosecution in this application. This election is made with traverse and without prejudice to Applicants' right to file divisional applications directed to the non-elected subject matter.

Applicants disagree with the Examiner's reasoning that restriction is required. Applicants respectfully urge that the Restriction Requirement does not establish that searching all the inventions would constitute an undue burden to the Patent Office. Moreover, Applicants urge that the Restriction Requirement is contrary to public policy. Accordingly, Applicants submit that the Restriction Requirement is improper and should be withdrawn or at least modified.

The MPEP lists two criteria for a proper restriction requirement. First, the invention must be independent or distinct. MPEP § 803. Second, searching the additional invention must constitute an undue burden on the Examiner if restriction is not required. *Id.* The MPEP directs the examiner to search and examine an entire application “[i]f the search and examination of an entire application can be made without serious burden...even though it includes claims to distinct or independent inventions.” *Id.*

Applicants urge that the Restriction Requirement, *inter alia*, does not meet the second of these criteria as the search for the present claimed invention is intrinsically simple and monolithic in that it involves simply a search of the art for reference to lysine pegylated alpha interferon which would necessarily and straightforwardly expose any prior art that might disclose any of the nine possible lysine points of attachment and their isolation....if such prior art existed. Therefore, searching the claims of Group I would not pose a serious burden on the Examiner, nor has the Examiner given any credible explanation of how it would. The restriction is accordingly improper for this reason alone and should be withdrawn.

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Further, Applicants respectfully disagree with the Examiner's bases for restriction. The present claims clearly represent a narrow and closely interrelated genus of species. Restricting the claims in the manner suggested in the Restriction Requirement, constitutes an undue burden to Applicants as well as to the public. The cost of prosecuting and maintaining additional patents is unreasonable in view of the fact that the species are so closely related. Further, the public is inconvenienced as they will not know whether or not Applicants will file a divisional application to the remaining subject matter. Accordingly, the public will not know if they can practice the remaining invention without infringing future patent applications.

Accordingly, in view of the foregoing, reconsideration and withdrawal of the restriction, at least as regards the species requirements, is respectfully requested.

No fee is believed required for consideration of this paper. If any fee is deemed necessary, authorization is given to charge the amount of any such fee to Deposit Account No. 08-2525.

Respectfully submitted,



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